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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

David J. Najewicz et al.

Serial No.: 10/814,722

Filed: March 31, 2004

For: ENHANCED BURNER
PERFORMANCE GAS RANGE
SYSTEM AND METHOD

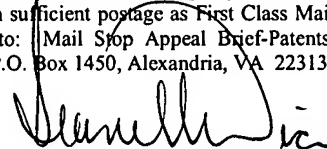
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Group Art Unit: 3749

Examiner: Cocks, Josiah C.

Atty. Docket: 135091-1/YOD/WOL
GERD:0111

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REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41

Appellants submit this Reply Brief pursuant to 37 C.F.R. § 41.41, and in response to the Examiner's Answer mailed on February 15, 2007. This Reply Brief highlights the underlying deficiencies of the contentions made by the Examiner in the Examiner's Answer with respect to the combination of the Rothenberger reference with the Adams reference. Appellants, however, respectfully request that the Board consider Appellants' complete arguments set forth in the previously filed Appeal Brief, in addition to the following remarks.

Appellants respectfully urge the Board to review and reverse the Examiner's first ground of rejection in which the Examiner rejected claims 1-4, 6-9, 11-14, 16-20, and 22-39 under 35 U.S.C. § 103(a) as being unpatentable over Rothenberger et al. (U.S. Patent No. 6,287,108, hereinafter "Rothenberger") in view of Adams et al. (U.S. Patent No. 6,178,997, hereinafter "Adams").

Deficiencies of the Rejection

Notwithstanding the Examiner's contentions in the "Response to Argument" section of the Examiner's Answer (pages 7-11), Appellants respectfully submit that the Examiner has still failed to establish a *prima facie* case of obviousness with regard to claims 1-4, 6-9, 11-14, 16-20 and 22-39 of the present application. As stressed throughout the Appeal Brief, neither Rothenberger nor Adams, taken alone or in combination, teach or suggest both a gas fuel boost pump and a pressure regulator, where the gas boost pump is disposed downstream of a pressure regulator to boost the pressure of the gas flow. Consequently, the cited references simply cannot support the Examiner's rejection.

First, Appellants would like to emphasize that the Examiner has significantly changed his position from the one asserted in the pre-appeal official actions. Further, the post Appeal Brief Examiner's Answer was the first time that the Examiner articulated this new position. Notwithstanding the Examiner's change in position, Appellants respectfully submit that the prosecution history shows that the Examiner has failed to provide support for either his original position or the newly asserted position.

Specifically, the Examiner's original position was that Rothenberger clearly discloses a "pressure regulator in the form of an actuating device" where the "actuating device includes a valve (4), motor (10), and actuator (9) that is also connected to the controller (7)." *See* Office Action mailed November 3, 2005, page 3. Additionally, the Examiner relied on Adams to suggest that a pump could be substituted for the pressure regulator in Rothenberger. *See id.*, page 4. In response to this argument, Appellants correctly pointed out that even if, hypothetically speaking, one of ordinary skill in the art would make such a substitution, the proposed combination was still deficient because it would not include both a pressure regulator and a gas fuel boost pump.

The Examiner responded to the Appellants' argument by stating that "Rothenberger clearly discloses a valve in addition to a pressure regulator (see

Rothenberger, at least Fig. 1)”. *See* Final Office Action mailed April 21, 2006, page 7 (emphasis added). First, not only is this statement clearly erroneous, but a simple examination of Fig. 1 of Rothenberger could lead to no other conclusion. Moreover, the Examiner contradicted his own assertion when he stated that the pressure regulator disclosed in Rothenberger is the valve which “regulate[s] gas flow through a gas feed line.” *See id.*, page 3. One of ordinary skill in the art would *not* find that the valve was in addition to a pressure regulator. Appellants, on multiple occasions, clearly pointed out this flaw in the Examiner’s reasoning, and now ask the Board to reverse the Examiner for at least this reason. *See* Response to Office Action mailed November 3, 2005, pages 10-11; *see also*, Pre-Appeal Brief Request for Review mailed June 19, 2006, page 3.

Appellants emphasize that it is only now, after considerable time and effort have been expended, that the Examiner has abandoned his original “clearly supported” argument and articulated a new position. Specifically, the Examiner now concedes that Rothenberger fails to disclose the “presence of both a regulator and a gas boost pump.” *See* Examiner’s Answer, bottom of page 7 to top of page 8. Appellants are troubled that the Examiner is just now adopting this new position. One would believe that this change would have been more appropriate well before the Examiner’s Answer in an Appeal Brief. Indeed, three of the five independent claims have never been amended, and the only amendments to the other independent claims were submitted with the response to the first Office Action. *See* Response to Office Action mailed November 3, 2005, pages 2-7. Therefore, the Examiner’s change in position was not necessitated by amendments.

In sum, Appellants believe that the prosecution history shows that the Examiner is resorting to hindsight reconstruction and has clearly failed to meet the goals of examination. *See* M.P.E.P. § 706, (“[t]he goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity.”) (emphasis added).

Notwithstanding this change, Appellants will address the Examiner's new position but believe that this illustrates that the Examiner is either uncertain or unclear of what the cited references teach or suggest. Further, Appellants respectfully submit that the prosecution history appears to suggest arbitrary and capricious judgment based on the Examiner's subjective beliefs about the patentability of the present invention, and is completely devoid of any objective evidence whatsoever. *See In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Moreover, the Examiner's subjective beliefs are especially troublesome in an obvious rejection, where the Examiner must strive for an objective standard from the perspective of one of ordinary skill in the art. Appellants respectfully urge the Board to carefully consider the arguments made by the Examiner in light of the prosecution history. Moreover, Appellants will show that the Examiner relied on hindsight reconstruction to pick and choose among isolated disclosures to deprecate the claimed invention. *See In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Finally, Appellants will show that the Examiner's circular reasoning is in direct conflict with the suggested motivation to combine, and that the references actually teach away from the purported combination.

In the Examiner's Answer, the Examiner stated that it is well understood in the art that pressure regulators may be substituted for control valves. *See Examiner's Answer*, bottom of page 8. The Examiner then suggested that the pressure regulator disclosed in Adams may be substituted for the control valve in Rothenberger. *See id.*, bottom of page 8 through top of page 9. Appellants note first that this still does not provide for both a pressure regulator and a gas fuel boost pump.

Next, the Examiner made the incorrect statement that Adams discloses a valve (12) in Fig. 2A. *See id.*, bottom of page 9. First, Adams does not disclose a valve (12) in Fig. 2A, but instead discloses a regulator body (12) in Fig. 2A. *See Adams*, col. 1, line 45; *see also*, Fig. 2A. Further, the regulator body (12) is part of a main regulator (10)

which again is not a valve. *See id.*, col. 2, line 42. Simply put, Adams does not teach a valve (12) as asserted by the Examiner, but instead teaches a pressure regulator (10) that includes a regulator body (12). While, Adams suggests that a pressure regulator may contain a valve, as well as a number of other components (*e.g.*, a process sensor, a controller); this is not consistent with the Examiner's statements. As discussed in more detail below, Appellants respectfully submit that the only reason the Examiner would make such an incorrect statement is because he is relying on hindsight reconstruction. In sum, the Examiner appeared to realize that he needs to subjectively transform regulator body (12) into a valve to later logically replace this valve in the proposed combination.

Moreover, the Examiner's reliance on hindsight reconstruction becomes even more apparent when one considers what the Examiner suggested as a whole. First, as discussed above, the Examiner suggested that one of ordinary skill in the art would replace the valve in Rothenberger with a pressure regulator from Adams. *See Examiner's Answer*, bottom of page 8. Next, the Examiner suggests that one of ordinary skill in the art would then replace that same pressure regulator with a valve. *See id.*, bottom of page 9. This is clearly a circular argument and is indicative of the erroneous nature of this rejection.

Further, Appellants question the Examiner's purported suggestion to combine in light of this circular argument. As discussed above, the Examiner suggested replacing the valve in Adams with a gas fuel boost pump. The Examiner relied on the statement from Adams that a variable speed pump may be used instead of a valve. *See Adams*, col. 1, line 28-30. First, Appellants respectfully disagree that Adams suggests that it is well known that a valve, included in a self contained pressure regulator, would be replaced by a pump. Appellants submit that the Examiner is taking Adams' suggestion out of context in order to make an unsupported substitution. Indeed, Adams states that a "pressure regulator is a simple, self-contained control system that combines the process sensor, the

controller and the valve into a single unit.” *See id.*, col. 1, lines 32-34 (emphasis added). Further, Adams states that pressure regulators have many advantages over other control devices (*i.e.*, variable speed drive of a pump) because they are inexpensive and do not require an external power source. *See id.* col. 2, lines 46-49. Therefore, Appellants submit that Adams does not suggest to one of ordinary skill in the art to replace an unpowered component (*i.e.*, a pressure actuated valve) with a powered component (*i.e.*, a variable speed drive pump) in a self-contained pressure regulator.

Further, Appellants submit that such a suggestion would explicitly be in conflict with the Examiner’s suggested motivation to combine, that motivation being to create “a device that is relatively inexpensive, does not require an external power source, and is self contained package.” *See* Examiner’s Answer, top of page 9. Therefore, despite the Examiner’s assertion, Adams does not teach or suggest that a pump may be substituted for a valve included in a self-contained pressure regulator.

Finally, the Examiner has failed to address the explicit statements of Adams, even though he relies on these explicit statements for the basis of his circular reasoning. Adams states that “[in] many situations to which pressure regulators could be applied, control valve are used instead” and that a variable speed drive pump may be used instead of a valve. *See* Adams, col. 1, lines 29-30; *see also*, col. 3, lines 48-49 (emphasis added). Appellants submit that the explicit and unambiguous key operative words are “instead of.” Adams specifically teaches that one device may be used instead of the other, and not that one device may be used in addition or in conjunction with another. As discussed above, all of the appealed claims include both a pressure regulator and a gas fuel boost pump. The Examiner selectively ignored that Adams explicitly teaches away from using both a pressure regulator and a gas fuel boost pump. Further, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *See In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d. 1430 (Fed. Cir. 1990).

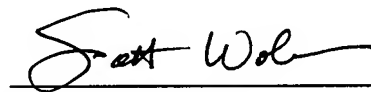
In sum, the motivation to combine is clearly inconsistent with the specific teachings of the prior art because Rothenberger and Adams teach that the devices are used instead of one another and not in conjunction with one another.

The Examiner's change in position, as well as the newly formulated circular reasoning demonstrates that the Examiner relied on hindsight reconstruction in forming the rejection. Further, the Examiner's suggested motivation for combination is in opposition to the teachings of the art. Once again, Appellants respectfully request reversal of the rejections under 35 U.S.C. § 103(a), and request allowance of claims 1-4, 6-9, 11-14, 16-20, and 22-39, as well as the remaining claims, the rejections of which were founded on the same underlying combination.

Based upon the above points of clarification in conjunction with the arguments made in the previously filed Appeal Brief, Appellants believe that the claims are clearly allowable over the cited art. The Examiner's rejections, therefore, cannot stand. Appellants respectfully request that the Board withdraw the outstanding rejections and pass the present application to allowance.

Respectfully submitted,

Date: April 16, 2007



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